

The Examiner therefore required restriction of the application, pursuant to 35 U.S.C. § 121, to one of the two inventions.

Applicant's Reply to the Restriction Requirement

Applicant hereby elects with traverse the invention of Group I (claims 1-11) for examination in this application. This election is expressly without waiver of applicant's right to pursue claims 12-19 in one or more divisional applications.

Applicant respectfully submits that the restriction requirement is improper. Restriction is proper only when two or more claimed inventions "are able to support separate patents and they are either independent or distinct" (Manual of Patent Examining Procedure ("M.P.E.P.") § 803, emphasis added). Because the inventions defined by Groups I and II are neither independent nor distinct, applicant respectfully requests that the restriction requirement be withdrawn.

First, the inventions defined by Groups I and II are not independent. According to § 802.01 of the M.P.E.P., "'[i]ndependent', of course, means *not dependent*" (emphasis added). Each and every claim in Group II, however, is dependent from a claim in Group I. Specifically, claims 12-19 depend from claim 1. Therefore, Groups I and II are not independent.

Second, the inventions defined by Groups I and II are not distinct. The term "distinct" means "that two or more subjects as disclosed are related, for example, as . . . process and product made, etc., but are capable of separate manufacture, use, or sale as claimed, AND ARE PATENTABLE (novel and unobvious) OVER EACH OTHER (though they may each be unpatentable because of the prior art)" (M.P.E.P. § 802.01, emphasis in original). In fact, in order to show that a process of making and a product made by the process are distinct inventions, the Examiner must show either or both of the following: "(A) that the process *as claimed* is not an obvious process of making the product and the process as claimed can be used to make other and different products; or

(B) that the product *as claimed* can be made by another and materially different process" (M.P.E.P. § 806.05(f), emphasis added).

Applicant's independent claim 1 defines "a method of making an information-recording medium" comprising the steps of "providing a mark on a back surface of a stamper" and "forming a substantially transparent disc using said stamper." However, the Examiner has alleged that "[i]n the instant case, the product can be made by forming a substantially transparent extruded disc using a stamper" (Office Action, ¶ 2). Respectfully, applicant submits that this process demonstrated by the Examiner is not "materially different" from the process defined by applicant's claim 1, as is required by M.P.E.P. § 806.05(f). Because the claims in Group II include each and every feature of the independent claim in Group I, and because no materially different process (that can make applicant's claimed product) has been demonstrated by the Examiner, the product defined in Group II can not be restricted from the process defined in Group I. Accordingly, Groups I and II can not be distinct.

Moreover, pursuant to M.P.E.P. § 806.05, if the inventions as claimed are not distinct, "restriction is never proper." (emphasis added).

In light of the foregoing, applicant respectfully requests that the restriction requirement be withdrawn.

An early and favorable action is respectfully requested.

Respectfully submitted,



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